

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 5 of 11

REMARKS/ARGUMENTS

Claims 9-11 and 13-18 are pending in this application. By this Amendment, Applicant amends Claims 9 and 15-18 and cancels Claim 12.

Claims 9-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. (U.S. 2002/0008606) in view of Ibata et al. (U.S. 6,169,470). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view of Ibata et al., and further in view of Kobayashi (U.S. 6,229,425). Claim 12 has been canceled. Applicant respectfully traverses the rejections of Claims 9-11 and 13-18.

Claim 9 has been amended to recite:

A laminated ceramic electronic component comprising:
a ceramic laminated member;
an inner conductor provided inside of the ceramic laminated member;
an outer electrode provided on the surface of the ceramic laminated member; and
a lead conductor connecting the inner conductor to the outer electrode; wherein
a thickness of the lead conductor is less than a thickness of the inner conductor;
the lead conductor includes a plurality of lead conductor pattern layers that overlap and are in contact with each other;
the inner conductor includes a plurality of inner conductor pattern layers that overlap and are in contact with each other; and
the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers. (emphasis added)

The Examiner alleged that Okuyama et al. teaches all of the features recited in Applicant's Claim 9 except for the feature of a thickness of the lead conductor is less than a thickness of the inner conductor. The Examiner further alleged that Ibata et al. teaches the feature of a thickness of the lead conductor 7 is less than a thickness of the inner conductor 5. Thus, the Examiner concluded that it would have been obvious "to use the lead conductor thickness teaching of Ibata in the laminated ceramic electronic

Application No. 10/531,522

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 6 of 11

component of Okuyama et al. to provide excellent electrical characteristics, such as reduced stray capacity, and increase productivity (col. 2, lines 2-7 [of Ibata et al.].”

Applicant respectfully disagrees.

Contrary to the Examiner’s allegations, Ibata et al. fails to teach or suggest anything at all about the relative thicknesses of the lead conductor 7 and the inner conductor 5. Further, Ibata et al. neither teaches nor suggests that any advantages whatsoever are or could be obtained by making the thickness of the lead conductor 7 less than the thickness of the inner conductor 5. The advantages disclosed in col. 2, lines 2-7 of Ibata et al. are specifically disclosed as being produced as a result of the conductive member 5 having a plurality of turns that are gradually different, in diameter, from each other from one end towards the other end of the conductive member 5, and are certainly not disclosed as being a result of the thickness of the lead conductor 7 being less than the thickness of the inner conductor 5, as alleged by the Examiner.

The Examiner is reminded that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

Thus, the Examiner has committed clear legal error and has failed to establish a *prima facie* case of obviousness in the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view of Ibata et al.

In addition, although Fig. 1 of Ibata et al. appears to show the lead conductor 7 as having a thickness that is less than the inner conductor 5, the Examiner is reminded that, when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”).

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 7 of 11

Ibata et al. does not disclose that any of the drawings provided therein are drawn to scale and is completely silent as to dimensions of the thicknesses of the lead conductor 7 and the inner conductor 5. Thus, Fig. 1 of Ibata et al. clearly cannot be relied upon to allegedly teach the feature of “a thickness of the lead conductor is less than a thickness of the inner conductor” as recited in Applicant’s Claim 9.

Thus, even assuming *arguendo* that there would have been a reason to combine the alleged teachings of Ibata et al. with Okuyama et al., which there clearly would not have been, the combination of Okuyama et al. and Ibata et al. would still fail to teach or suggest the feature of “a thickness of the lead conductor is less than a thickness of the inner conductor” as recited in Applicant’s Claim 9.

On the Continuation Sheet of the Advisory Action date August 12, 2010, the Examiner alleged, “Ibata et al. clearly teaches a thickness of lead conductor 7 less than a thickness of inner conductor 5 (see Fig. 1 for illustration). An objective of the coil component of Ibata et al. is to provide excellent electrical characteristics such as reduced stray capacity (col. 2, lines 2-7). To achieve such objective, at least in part, a thickness of lead conductor is made or designed less than a thickness of inner conductor as shown throughout the figures. Therefore, the examiner has clearly established *prima facie* case of obviousness rejection.” Applicant respectfully disagrees.

Contrary to the Examiner’s allegations, as noted above, Ibata et al. fails to teach or suggest anything at all about the relative thicknesses of the of the lead conductor 7 and the inner conductor 5, and most certainly does not teach or suggest that the objective of providing excellent electrical characteristics, such as reduced stray capacity, is achieved in any way whatsoever, by making or designing the lead conductor to have a thickness that is less than a thickness of the inner conductor.

The Examiner’s allegation, “To achieve this objective, at least in part, a thickness of lead conductor is made or designed less than a thickness of inner conductor as shown throughout the figures,” is completely unsubstantiated by any teaching or suggestion in Ibata et al. or by any other evidence of record, and as such, constitutes a

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010

Page 8 of 11

clear legal error.

In addition, the Examiner's allegation that "Ibata et al. clearly teaches a thickness of lead conductor 7 less than a thickness of inner conductor 5," clearly contradicts well-established law that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.")

Since, as noted above, Ibata et al. does not disclose that any of the drawings provided therein are drawn to scale and is completely silent as to dimensions of the thicknesses of the lead conductor 7 and the inner conductor 5, contrary to the Examiner's allegations, Fig. 1 of Ibata et al. clearly cannot be relied upon to allegedly teach the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor" as recited in Applicant's Claim 9. Thus, the Examiner's allegation that Ibata et al. teaches the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor" as recited in Applicant's Claim 9 constitutes a clear factual error.

Furthermore, in order to expedite prosecution of the present application and to more clearly distinguish the Applicant's claimed invention over the prior art of record, Applicant's Claim 9 has been amended to recite the features of "the inner conductor includes a plurality of inner conductor pattern layers that overlap and are in contact with each other" and "the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers." Support for these features is found, for example, in Applicant's now canceled Claim 12.

With respect to Applicant's canceled Claim 12, the features of which are now recited in Applicant's Claim 9, the Examiner acknowledged that Okuyama "does not teach the laminated ceramic electronic component, wherein the number of lead conductor pattern layers of said plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of said plurality of inner conductor pattern layers." However, the Examiner further alleged, "Ibata teaches the laminated ceramic

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 9 of 11

electronic component, wherein the number of lead conductor pattern layers (2 layers) of said plurality of lead conductor 7 pattern layers is less than the number of inner conductor 5 pattern layers of said plurality of inner conductor pattern layers (4 layers). Thus, the Examiner concluded that it would have been obvious “to use the number of lead conductor pattern layers teaching of Ibata in the laminated ceramic electronic component of Okuyama to provide excellent electrical characteristics.” Applicant respectfully disagrees.

It appears that the Examiner has completely misconstrued the features of “the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers” recited in Applicant’s Claim 9 as requiring the number of lead conductors to be less than the number of inner conductors, instead of requiring the number of lead conductor pattern layers of a single lead conductor to be less than the number of inner conductor pattern layers of a single inner conductor.

Applicant’s Claim 9 requires (1) the lead conductor includes a plurality of lead conductor pattern layers that overlap and are in contact with each other; (2) the inner conductor includes a plurality of inner conductor pattern layers that overlap and are in contact with each other; and (3) the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers. That is, Applicant’s Claim 9 clearly and specifically requires that the number of lead conductor pattern layers of the plurality of lead conductor pattern layers that overlap and are in contact with each other is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers that overlap and are in contact with each other. In other words, Applicant’s Claim 9 requires that the number of lead conductor pattern layers of a single lead conductor that overlap and are in contact with each other be less than the number of inner conductor pattern layers of a single inner conductor that overlap and are in contact with each other.

Ibata et al. fails to teach or suggest any lead conductor pattern layers that

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 10 of 11

overlap and are in contact with each other, and thus, most certainly fails to teach or suggest the feature of the number of lead conductor pattern layers of a plurality of lead conductor pattern layers that overlap and are in contact with each other is less than the number of inner conductor pattern layers of a plurality of inner conductor layers that overlap and are in contact with each other as recited in Applicant's Claim 9. At best, Ibata merely teaches an input lead out electrode 6 that includes only a single lead conductor pattern layer and an output lead out electrode 7 that includes only a single lead conductor pattern layer. Ibata fails to teach or suggest that either of the lead out electrodes 6 and 7 could or should include a plurality of lead conductor pattern layers that overlap and are in direct contact with each other.

Thus, Ibata et al. clearly fails to teach or suggest the feature of "the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers" where the plurality of lead conductor pattern layers overlap and are in direct contact with each other as recited in Applicant's Claim 9.

Therefore, Applicant respectfully submits that Okuyama et al. and Ibata et al., applied alone or in combination fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claim 9.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Okuyama et al. in view of Ibata et al.

The Examiner relied upon Kobayashi to allegedly cure deficiencies of Okuyama et al. and Ibata et al. However, Kobayashi fails to teach or suggest the feature of "a thickness of the lead conductor is less than a thickness of the inner conductor," "the inner conductor includes a plurality of inner conductor pattern layers that overlap and are in contact with each other," and "the number of lead conductor pattern layers of the plurality of lead conductor pattern layers is less than the number of inner conductor pattern layers of the plurality of inner conductor pattern layers" as recited in Applicant's Claim 9. Thus, Kobayashi fails to cure the deficiencies of Okuyama et al. and Ibata et

Application No. 10/531,522

October 21, 2010

Reply to the Office Action dated May 6, 2010,
The Advisory Action dated August 12, 2010, and
The Notice of Panel Decision dated September 28, 2010
Page 11 of 11

al. described above.

Accordingly, Applicant respectfully submits that Okuyama et al., Ibata et al., and Kobayashi, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claim 9.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claim 9 is allowable. Claims 10, 11, and 13-18 depend upon Claim 9, and are therefore allowable for at least the reasons that Claim 9 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: October 21, 2010

/Christopher A. Bennett #46,710/
Attorneys for Applicant

KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191
Telephone: (571) 313-7440
Facsimile: (571) 313-7421

Joseph R. Keating
Registration No. 37,368
Christopher A. Bennett
Registration No. 46,710